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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,409	08/24/2004	Daisuke Kamiya	7378/84103	7763
42798	7590	09/06/2007		
FITCH, EVEN, TABIN & FLANNERY			EXAMINER	
P. O. BOX 18415			TRAN, THAO T	
WASHINGTON, DC 20036			ART UNIT	PAPER NUMBER
			1711	
			MAIL DATE	DELIVERY MODE
			09/06/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/505,409	<b>Applicant(s)</b> KAMIYA ET AL.	
	<b>Examiner</b> Thao T. Tran	<b>Art Unit</b> 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2007 and 10 May 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-7 and 9-12 is/are pending in the application.
- 4a) Of the above claim(s) 9-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Transitional After Final Practice***

1. This is in response to Applicants' Appeal Brief filed on 1/11/2007. Since this application is eligible for the transitional procedure of 37 CFR 1.129(a), and the fee set forth in 37 CFR 1.17(r) has been timely paid, the finality of the previous Office action is hereby withdrawn pursuant to 37 CFR 1.129(a).
2. Upon further consideration, the 102 rejections of the claims have been withdrawn. New 103 rejections of the claims are set forth below.
3. Claims 1-3, 5-7, and 9-12 are currently pending in this application. Claims 9-12 have been withdrawn as directed to a nonelected invention as indicated in the prior Office action.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasegawa et al. (US Pat. 6,559,231) or Okazaki et al. (US Pat. 6,645,617).

Hasegawa discloses a pressure sensitive adhesive sheet for coating a substrate, the pressure sensitive adhesive composition comprising a light curable copolymer (I) obtained by copolymerizing an ethylenically unsaturated monomer (a) having a maleimide group, an

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ethylenically unsaturated monomer (b) having a carbonyl group, and other ethylenically unsaturated monomer (c) (see abstract; col. 2, ln. 26-32).

The copolymer (I) of Hasegawa has a molecular weight of 1,000 to 1,000,000 and preferably 10,000 to 500,000 (see col. 7, ln. 9-12), overlapping the presently claimed range. Therefore, it would have been obvious to one of ordinary skill in the art to have selected the copolymer having a lower range of molecular weight, depending upon user's preference and intended use, absence of evidence to the contrary.

Monomer (a) having a maleimide group is a compound having Formula (1), wherein R1 and R2 each can be independently a hydrogen or an alkyl group (see col. 2, ln. 32-67), which reads on the formula in instant claims 1 and 5. Monomer (a) is an imide compound including imide (meth)acrylate that is produced from an acid anhydride, amino alcohol, and (meth)acrylic acid (ester) (see col. 3, ln. 39-41). Monomer (c) includes alkyl (meth)acrylate and hydroxyalkyl (meth)acrylate (see col. 4, ln. 21-29). Hasegawa further teaches the amount of monomer (a) is 4-20%, monomer (b) 2-25%, and monomer (c) 55-94% (see col. 4, ln. 45-48). Thus, copolymer (I) would inherently have a polyester backbone.

Okazaki discloses a pressure sensitive adhesive composition curable with actinic energy ray and pressure sensitive sheet on a substrate (see abstract; col. 1, ln. 12-19). The pressure sensitive adhesive composition comprises a copolymer comprising 0.1-3% by weight of an imide (meth)acrylate and 97-99.9% by weight of an unsaturated monomer (see col. 3, ln. 54-59). The imide (meth)acrylate has a chemical formula (1), wherein R1 and R1 can be independently a hydrogen or alkyl groups (see col. 2, ln. 12-67). The unsaturated monomer includes (meth)acrylate, unsaturated carboxylic acid, vinyl ester, monoalkyl esters of unsaturated

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dicarboxylic acid (see col. 4, ln. 11-21). Thus, the copolymer would inherently have a polyester backbone.

The copolymer of Okazaki has a molecular weight preferably in the range of 10,000-1,000,000 (see col. 5, ln. 45-52), overlapping the presently claimed range. Therefore, it would have been obvious to one of ordinary skill in the art to have selected the copolymer having a lower range of molecular weight, depending upon user's preference and intended use, absence of evidence to the contrary.

#### ***Response to Arguments***

6. Applicant's arguments with respect to the 102 rejections of the claims have been considered but are moot in view of the new ground(s) of rejection.

#### ***Contact Information***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 571-272-1080. The examiner can normally be reached on Monday-Friday, from 9:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Thao T. Tran  
Primary Examiner  
Art Unit 1711

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